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JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			LAFORGIA, CHRISTIAN A	
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			2131	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/657,604

Applicant(s)

BRANDENBURG ET AL.

Examiner

Christian La Forgia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-37 are presented for examination.

Drawings

2. The drawings are objected to because parts of Figure 2 exceeded the right margin and have therefore been cut off. Figures 3, 10, and 14 are also objected to as being illegible. Figures 3, 10, and 14 appear too dark to distinguish any parts or features of the instant invention. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

4. The attempt to incorporate subject matter into this application by reference to co-pending applications is improper because there are no serial numbers provided and the status of the co-pending applications is not given.

5. The use of the trademarks Windows, Java, Microsoft, and Netscape has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

6. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 101

7. As per claims 17-20, 26, 27, 30, 35, and 36 merely claimed as a computer program representing a computer listing *per se*, that is, descriptions or expressions of such a program and that is, descriptive material *per se*, non-functional descriptive material, and is not statutory because it is not a physical “thing” nor a statutory process, as there are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a

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process, without the computer-readable medium needed to realize the computer program's functionality. In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 18-21 recites the limitation "wherein the filter engine is adapted to return an object to the servlet" (Emphasis added). There is insufficient antecedent basis for this limitation in the claim.

10. Claims 19, 27, 30, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus claiming methods which are not clearly defined in the claim language render the claims indefinite.

11. Claim 22 recites the limitation "wherein if the integer value indicates that a signature is required on data in the HTTP request then the Internet server application stores a state of the filter engine in a cookie and causes a Web page containing the cookie and an instruction to sign

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the data to be transmitted to the Web browser" (Emphasis added). There is insufficient antecedent basis for this limitation in the claim.

12. Claim 28 contains the trademark/trade name Java. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an object oriented computer programming language and, accordingly, the identification/description is indefinite.

13. Claim 30 recites the limitation "wherein the rules class comprises the following methods: a getMode method, a getService method, a readRules method, a rulesMatch method, and a validateRules method " (Emphasis added). There is insufficient antecedent basis for this limitation in the claim.

14. Claims 31-35 recites the limitation "wherein the bank interface..." (Emphasis added). There is insufficient antecedent basis for this limitation in the claim.

15. Claim 36 recites the limitation "wherein the public class object comprises a createOCSPRequest method, a getCertificateID method, a getCertStatus method, a getCertsVerifyMessage method, a getURL method, an isResponseSuccessful method, a logAndBuildReturnObject method, a processOCSP method, a sendAndReceiveMessage method,

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a serviceRequest method, and a verifyResponseSignature method" (Emphasis added). There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claim 37 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,675,153 to Cook et al., hereinafter Cook.

18. As per claim 37, Cook teaches a system for integrating a seller's Web site with a public key infrastructure, comprising:

a Web server, see figures 1, blocks 106, 108, 3, blocks 106, 108, see also column 4, lines 42-46, column 5, lines 11-31;

a Web application connected to the Web server, the Web application adapted to identify HTTP requests that include data requiring signature and to create a Web page for transmission to a browser that will cause the browser to invoke a signing interface to sign the data, see figure 2, blocks 114, 118, see column 1, line 62 to column 2, line 6, column 5, lines 11-31, column 6, lines 17-28;

the Web application further adapted to identify HTTP requests that require a service provided by an entity other than the seller, see figures 1, block 108, 3, block 108, as well as column 3, lines 7-15; and

a bank interface adapted to receive a request for service from the Web application, format and transmit the request, receive a response to the request, and forward the response to the Web application, see figure 1, blocks 102, 104, 3 blocks 102, 104, as well as column 4, lines 56-64, column 9, line 23 to column 10, line 8.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1- 3, 5-9, 20, 21, 23-25, 28, 29, and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over SET as taught by U.S. Patent No. 6,327,578 to Linehan, hereinafter referred to as SET, in view of U.S. Patent No. 5,717,989 to Tozzoli et al., hereinafter Tozzoli.

21. As per claim 1, SET teaches a system for integrating a seller's Web site with a public key infrastructure, the Web site comprising a Web server and a Web application, the public key infrastructure comprising a buyer computer comprising a Web browser adapted to invoke a signing interface to digitally sign electronic messages, the public key infrastructure further comprising a seller's bank computer system adapted to receive service requests from the seller and respond to those requests with digitally signed service responses; the system comprising:

redirecting HTTP requests received from the Web browser, see figure 1, see also column 3, lines 15-23, i.e. while on the internet, "the merchant's computer 104 forwards the consumer's payment request over internet path 122 during a second step to an acquirer gateway 106 operating on behalf of the acquirer bank 108";

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an Internet server application adapted to receive a redirected HTTP request and process the redirected HTTP request, see figure 1, see also column 3, lines 23-32, i.e. "The acquirer gateway 106 passes the consumer's payment request to the acquirer bank 108 over a private network path 122'. The acquirer bank 108 sends the consumer's payment request to the card issuing bank 112 over the private network path 124 to check whether the consumer's credit or debit card account is active and sufficient for the proposed transaction with the merchant. The issuing bank 112, as the card issuer, authorizes the transaction in a message sent over the private path 126 to the acquiring bank 108. The acquiring bank 108 sends the transaction authorization over private path 128' to the acquirer gateway 106, signing the message with the acquiring bank's digital signature";

receiving the processed HTTP request and identify an HTTP request that contains data requiring signature by the buyer, see figure 1 and column 3, lines 32-39, i.e. "The acquirer gateway 106 forwards it over the internet path 128 to the merchant, authorizing from the merchant to proceed with the transaction. Once the merchant has received the transaction authorization from the acquirer gateway 106, the merchant completes the sales transaction with the consumer."

22. SET does not disclose the use of a filter or filter engine.

23. Tozzoli discusses the use of filtering when processing transactions over the Internet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include filtering, since Tozzoli discloses in column 11, lines 52-57 that such a modification allows the merchant to verify and access data fields quickly and process the order accurately.

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24. Regarding claim 2, SET discloses a bank interface adapted to receive the request and transmitting the request to the seller's bank in figure 1, blocks 106, 122', and 142', as well as column 3, lines 13-47.

25. Tozzoli discloses the filter engine and reformatting the request in figures 3a-3c, column 7, line 42 to column 8, line 3, column 11, lines 52-58, and column 12, line 64 to column 13, line 4.

26. With regards to claim 3, SET teaches wherein the bank interface is further adapted to receive a service response to the request from the seller's bank and forward the response to the filter engine, see figure 1, as well as column 3, lines 13-47.

27. Regarding claim 5, Tozzoli teaches a second Web server adapted to parse requests redirected by the filter, see figure 5, as well as column 7, line 53 to column 8, line 12.

28. Regarding claim 6, SET teaches wherein services provided by the seller's bank are provided within the context of a four-corner model, see figure 1.

29. With regards to claim 7, SET teaches wherein the four-corner model comprises the buyer, the seller, the seller's bank, and a buyer's bank, see figure 1, where the buyer is the consumer, block 102, the seller is the merchant, block 104, the seller's bank is the acquiring bank, block 108, and the buyer's bank is the issuing bank, block 112.

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30. Regarding claim 8, neither SET nor Tozzoli disclose wherein the filter is implemented using ISAPI.

31. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the filter using ISAPI, since it has been held that ISAPI is an easy-to-use, high performance interface for back-end applications and has significant performance advantages over the CGI specification, such as having its own dynamic-link library.

32. Regarding claim 9, SET teaches wherein the Internet service application is adapted to generate HTTP responses based on data received from the filter engine, see column 3, lines 13-47.

33. Regarding claim 20, SET teaches wherein the filter engine is adapted to return an object to the servlet, see column 3, lines 28-36.

34. With regards to claim 21, SET teaches wherein the object comprises an integer value indicating one of four conditions: that a signature is required on data in the HTTP request, that a response has been received from the seller's bank concerning a service request, that the HTTP request has been passed through to the Web application, or that an error occurred, see column 3, lines 28-47.

35. Regarding claim 23, Tozzoli and SET do not teach wherein the filter engine determines whether an HTTP request contains data requiring signature by applying filtering rules.

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36. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the filter engine determine if the data required a signature, since SET discloses at column 3, lines 62-47 that such a modification would ensure that the transaction was authorized by the appropriate user.

37. Regarding claim 24, Tozzoli and SET do not teach wherein the filter engine is programmed to recognize each HTTP request that includes data requiring signature.

38. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the filter engine recognize that the data has a digital signature, since SET discloses at column 3, lines 62-47 that such a modification would ensure that the transaction was authorized by the appropriate user.

39. Regarding claim 25, Tozzoli and SET do not teach wherein the filter engine is programmed to recognize HTTP requests transmitted by the Web browser that have been modified to include a special tag that indicates whether the request includes data that requires signature.

40. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the filter engine recognize special tags that indicate the request for a digital signature, since SET discloses at column 3, lines 62-47 that such a modification would ensure that the transaction was authorized by the appropriate user.

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41. Regarding claim 28, neither SET nor Tozzoli teach wherein the filter engine provides an abstracted front-end interface via java remote method invocation.

42. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the filter to comprise of an abstracted front-end, since it has been held that an abstracted front-end is an easy-to-use, high performance interface for linking to back-end applications.

43. Regarding claim 29, Tozzoli teaches wherein the filter engine employs a rules class, see column 11, line 52 to column 12, line 11.

44. Regarding claim 31, neither SET nor Tozzoli teach wherein the bank interface is designed with a plug-in based architecture.

45. Linehan discloses wherein the bank interface is designed with a plug-in based architecture. It would have been obvious to one of ordinary skill in the art at the time the invention was made to design the bank interface with a plug-in based architecture, since Linehan discloses at column 9, lines 3-28 that such a modification would allow the bank to operate with foreign consumers.

46. Regarding claim 32, SET and Tozzoli do not teach wherein the bank interface supports an abstract front-end interface to allow communication via a plurality of middleware technologies.

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47. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the filter to comprise of an abstracted front-end, since it has been held that an abstracted front-end is an easy-to-use, high performance interface for interacting with middleware from a plurality of vendors.

48. Regarding claim 33, SET teaches wherein the bank interface is adapted to create and transmit OCSP requests, see column 3, lines 25-47.

49. Regarding claim 34, SET teaches wherein the bank interface comprises a certificate status check module, see column 3, lines 25-47.

50. Claims 4 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over SET in view of Tozzoli as applied to claim 2 above, and further in view of Linehan.

51. With regards to claim 4, SET does not disclose wherein the service is certificate validation.

52. Linehan discloses certificate validation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include certificate validation, since Linehan states at column 4, lines 23-44 that such a modification would serve to validate that the payment was authorized by the card holder.

53. Regarding claim 22, neither SET nor Tozzoli disclose wherein if the integer value indicates that a signature is required on data in the HTTP request then the Internet server

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application stores a state of the filter engine in a cookie and causes a Web page containing the cookie and an instruction to sign the data to be transmitted to the Web browser.

54. Linehan teaches wherein if the integer value indicates that a signature is required on data in the HTTP request then the Internet server application stores a state of the filter engine in a cookie and causes a Web page containing the cookie and an instruction to sign the data to be transmitted to the Web browser. It would have been obvious to one of ordinary skill in the art at the time the invention was made to store the state of the system to send an indication that the data has to be signed, since Linehan discloses at column 4, lines 9-44 that such a modification would limit the number of unauthorized transactions.

55. Claims 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over SET in view of Tozzoli as applied to claim 1 above, and further in view of U.S. Patent No. 6,052,785 to Lin et al., hereinafter Lin.

56. Regarding claim 10, neither SET nor Tozzoli disclose wherein the Internet server application is adapted to pass a hash table to the filter engine.

57. Lin teaches wherein the Internet server application is adapted to pass a hash table to the filter engine. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the server application pass a hash table to the filter engine, since Lin discloses at column 8, lines 43-56 that such a modification supports authentication, which is necessary to prevent fraudulent transactions.

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58. With regards to claim 11, Lin teaches wherein the hash table comprises the headers from the redirected HTTP request, see figure 3, as well as column 8, line 51 to column 9, line 17.

59. With regards to claim 12, Lin teaches wherein the hash table comprises the method of the redirected HTTP request, see figure 3, as well as column 8, line 51 to column 9, line 17.

60. With regards to claim 13, Lin teaches wherein the hash table comprises the content-type of the redirected HTTP request, see figure 3, as well as column 8, line 51 to column 9, line 17.

61. With regards to claim 14, Lin teaches wherein the hash table comprises the buyer computer's IP address, see figure 3, as well as column 8, line 51 to column 9, line 17.

62. With regards to claim 15, Lin teaches wherein the hash table comprises the actual data in the redirected HTTP request, see figure 3, as well as column 8, line 51 to column 9, line 17.

63. With regards to claim 16, Lin teaches wherein the hash table comprises a unique session ID, see figure 3, as well as column 8, line 51 to column 9, line 17.

Claim Objections

64. Claims 18 and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or

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rewrite the claim(s) in independent form. Dependent claims should refer to preceding claim.

See MPEP § 608.01.

Remarks

65. The Applicant is reminded that the recitation of limitations in the preamble has not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hiraio*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

65. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

66. The following patents are cited to further show the state of the art with respect to secure electronic transactions, such as:

United States Patent No. 6,763,459 to Corella, which is cited to show a public key infrastructure that includes an off-line registration authority that comprises a hash table.

United States Patent No. 6,601,759 to Fife et al., which is cited to show providing feedback in an interactive payment system.

United States Patent No. 6,105,012 to Chang et al., which is cited to show a financial transaction processing system including one financial server connected through a public network to a number of users.

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United States Patent No. 6,125,352 to Franklin et al., which is cited to show conducting commerce over a distributed network.

United States Patent No. 6,003,765 to Okamoto, which is cited to show implementing an electronic cash system with a surveillance institution.

United States Patent No. 6,081,790 to Rosen, which is cited to show secure presentment and payment over open networks.

United States Patent No. 6,363,365 to Kou, which is cited to show secure bidding over an open network.

United States Patent No. 6,711,679 to Guski et al., which is cited to show public key infrastructure delegation.

United States Patent No. 5,850,442 to Muftic, which is cited to show secure commerce over an open network.

United States Patent No. 6,356,878 to Walker et al., which is cited to show a conditional purchase offer buyer agency system.

United States Patent No. 5,511,121 to Yacobi, which is cited to show a unique electronic cash system that protects the privacy of users.

United States Patent No. 5,557,518 to Rosen, which is cited to show a system for open electronic commerce having a customer trusted agent.

67. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (703) 305-7704. The examiner can normally be reached on Monday thru Thursday 7-5.

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68. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

69. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christian LaForgia
Patent Examiner
Art Unit 2131

clf


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